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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/695,632

10/27/2003

Brian G. Connor

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EXAMINER

DOWE, KATHERINE MARIE

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

04/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/695,632	<b>Applicant(s)</b> CONNOR ET AL.	
	<b>Examiner</b> KATHERINE M. DOWE	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,8,11-17,20-22,24-26,31,39-52,55,56,59,60,68 and 69 is/are pending in the application.
- 4a) Of the above claim(s) 44-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,8,11-17,20-22,24-26,31,39-43,55,56,59,60,68 and 69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/27/2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 23, 2008 has been entered.
2. Claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31, 39-52, 55, 56, 59, 60, 68, and 69 are currently pending.

### ***Election/Restrictions***

3. Newly submitted claims 44-52, as amended December 23, 2008, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed toward a scissors-type device. Previous claims have been directed toward a curette device of Figures 2-5.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 44-52 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31, 39-43, 55, 56, 59, 60, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drasler et al. (US 5,496,267) in view of Plechinger et al. (US 5,318,518). Regarding claims 1-3, 6, 8, 25, 26, 31, 43, 55, 56, 59, 60, 68, and 69, Drasler et al. disclose the invention substantially as claimed including a surgical cutting instrument comprising a nozzle (122) located at the distal end of the instrument that is shaped to form a liquid jet (124), a pressure lumen (114) configured to convey a flow of liquid to the nozzle, and an evacuation lumen (128) located between the nozzle and the proximal end of the instrument in the axial direction, comprising a jet-receiving opening (distal end of 128) located opposite the nozzle to receive at least a portion of the liquid jet emitted from the nozzle and convey a flow of liquid away from the jet receiving opening (Fig 3a). The instrument defines a cup-shaped tissue receptacle configured to contain excised tissue (area defined by 126, 114, and 122 and shown enclosing target 120 in Fig 3A) and may be considered a curette. However, Drasler et al. do not disclose a non-liquid jet tissue-excision component. Plechinger et al. disclose a similar surgical cutting instrument comprising a nozzle (14) for delivering a liquid jet and an evacuation lumen (18) located opposite the nozzle. Plechinger et al. teach the device may additionally comprise a non-liquid jet tissue-excision component (50), or cutting edge, on the distal end of the nozzle (Fig 7). Therefore, it would have been obvious to one having ordinary skill in the

Art Unit: 3734

art at the time the invention was made to modify the device of Drasler et al. such that the distal end of the nozzle (124), which is substantially opposite the jet-receiving opening (distal end of 128), comprised a non-liquid jet tissue-excision component with a sharpened edge that extends radially outward from an axial center of the nozzle to a radial periphery in view of Plechinger et al. With such a modification, the non-liquid jet tissue-excision component can excise large pieces of tissue enabling the liquid jet to more easily emulsify and remove the tissue.

Regarding claims 11-17, the pressure lumen is configured to enable it to convey a high-pressure liquid at a pressure of at least 30,000 psig (col 4, ll 51-67).

Regarding claims 20 and 24, the evacuation lumen (128) is shaped and positioned to enable it to remove at least a portion of excised tissue and essentially all of the liquid comprising the liquid jet, without the need for external suction (col 6, ll 17-21).

Regarding claims 21 and 22, the distal end of the device is capable of being inserted into the spine of a patient.

Regarding claims 39-42, Drasler et al. do not disclose if the instrument is disposable. However, it is well known in the art to make medical devices completely or partially disposable to ensure sterility and remove the risk of cross-contamination between patients.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31, 39-43, 55, 56, 59, 60, 68, and 69 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHERINE M. DOWE whose telephone number is (571)272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/

Application/Control Number: 10/695,632

Page 6

Art Unit: 3734

Primary Examiner, Art Unit 3734

Katherine Dowe

March 23, 2009

/K. M. D./

Examiner, Art Unit 3734